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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS F. BEAVEN
JANET AHLGREN,
KEVIN KELLEY,
GORHAM PALMER, and
STUART E. RUDOLPH

Appeal 2008-004673
Application 10/765,424
Technology Center 3600

Decided: December 4, 2009

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Douglas F. Beaven, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 4-10 and 37-43. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE¹ and enter new grounds of rejection pursuant to 37 CFR § 41.50(b).

THE INVENTION

This invention is a system “for improving communication among people who are collaborating in the performance of a task.” Specification 1:18-19.

Claim 37, reproduced below, is illustrative of the subject matter on appeal.

37. A system for supporting management of a collaborative activity by persons involved therein, the persons not being specialists in information technology and the system comprising:
a representation of a model of the collaborative activity, the representation being accessible to a processor, the model of the collaborative activity including model entities that are organized into hierarchies and provide access

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Sep. 17, 2007) and Reply Brief (“Reply Br.,” filed Feb. 12, 2008), and the Examiner’s Answer (“Answer,” mailed Dec. 12, 2007).

to information concerning the collaborative activity,

- the model entities having types including
 - a goal model entity type, model entities of the type representing goals and/or projects of the collaborative activity and
 - an initiative model entity type, model entities of the type serving to relate goal model entities across the model, and
- the hierarchies including
 - a goal hierarchy whose members include at least one goal model entity, a given goal model entity belonging to only a single goal hierarchy and
 - an initiative hierarchy whose members include at least one initiative model entity, each initiative model entity being capable of having as children one or more initiative model [entities] and/or one or more goal model entities from one or more of the goal hierarchies; and
- a graphical user interface for the system which the processor provides to the persons, the graphical user interface permitting a person of the persons to perform operations on a model entity including creating, modifying, and/or deleting the model entity, assigning the model entity to a parent in a hierarchy, accessing and/or modifying the information concerning the collaborative activity via the model entity, and viewing model entities in a hierarchy of the hierarchies to which the model entities belong.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bhaskaran

US 6,157,915

Dec. 5, 2000

Official Notice was taken that “it is old and well known in the art to submit a model to be executed by a processor.” Answer 7. (Official Notice I)

Official Notice was taken that “a second visible part which shows specific detailed information from the first visible part is old and well known in the art.” Answer 8. (Official Notice II)

The following rejections are before us for review²:

1. Claims 4-10, 37, 38, and 40-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bhaskaran and Official Notice I.
2. Claim 39 is rejected under 35 U.S.C. §103(a) as being unpatentable over Bhaskaran, Official Notice I, and Official Notice II.

ISSUE

Would one of ordinary skill in the art have been led by Bhaskaran and Official Notice I to a system having a representation of a model of a collaborative active that includes model entities in hierarchies as recited in claim 37 and having a graphical user interface which is structured to permit viewing of the model entities in a hierarchy of hierarchies to which the model entities belong?

² The Appellants also traverse the Examiner’s objection to claim 43 as being an improper dependent claim. App. Br. 11. However, this objection is a petitionable matter and not an appealable matter. Therefore, we will not address the matter. *See in re Hengehold*, 440 F.2d 1395, 1403-04 (CCPA 1971).

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

Bhaskaran

1. Bhaskaran describes an apparatus for collaborative management of a supply chain. Col. 1, ll. 8-12.
2. Bhaskaran's Figure 1 depicts a supply chain for computer storage products (col. 3, l. 13), including vendors, sub-assemblers, final assemblers, and a distributor in hierarchy. Figure 1.
3. Bhaskaran's invention is a system that allows the role players (*e.g.* sub-assemblers) of the supply chain to collaborate (col. 4, ll. 30-45) by creating business scenarios in active documents windows. *See* col. 2, ll. 33-46 and col. 5, ll. 50-54. Fig. 3 and 3A.
4. Bhaskaran describes a business scenario as a plan for the supply, manufacture and distribution of a product throughout the supply chain. Col. 5, ll. 51-52.
5. Bhaskaran describes that the active document window can be access by a graphical user interface. *See* col. 4, l. 56 – col. 5, l. 3 and Figs. 2-4.
6. Bhaskaran describes an access control list 500, which lists the role players (*e.g.* distributor), that maintains the roles of the players. Col. 6, ll. 25-31 and Fig. 5.

7. Bhaskaran also describes that the access control list authenticates and defines the system behavior for the various role players. Col. 6, ll. 27-30.
8. Bhaskaran describes that a role player's access to active documents can be limited based on sensitivity of information and need. Col. 5, l. 65 - col. 6, l. 4.

Any differences between the claimed subject matter and the prior art

9. The Examiner admits that Bhaskaran does not teach that the representation of the model of the supply chain in Figure 1 is "accessible to a processor." Answer 7.
10. Bhaskaran does not describe that the depiction of the flow chart of the supply chain in Fig. 1 is displayed in the windows of the system in Bhaskaran.
11. Bhaskaran's access control list shown in Figure 5 does depict the entities of the supply chain in a hierarchy of the hierarchies to which the model entities belong.
12. Bhaskaran does not describe the business scenarios or associated documents in the windows permitting viewing of the entities in a hierarchy of the hierarchies to which the model entities belong

The level of skill in the art

13. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of systems for communication among people who are collaborating in a task. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level

of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

14. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 4-10, 37, 38, and 40-43 under §103(a) as being unpatentable over Bhaskaran and Official Notice I.

The Appellants traverse the Examiner's finding that Figure 1 of Bhaskaran discloses the claimed representation of a model and that Bhaskaran's system, including the active document windows, allows operations on the model of Figure 1. *See App. Br. 6-8 and Reply Br. 1-4.* The Appellants specifically argue that windows of Bhaskaran do not permit assigning the model entity to a parent in a hierarchy and viewing model entities in a hierarchy of the hierarchies to which the model entities belong. App. Br. 6. The Appellants argue that Bhaskaran's system is a system that allows the entities in Figure 1 to collaborate together through windows of active documents and that the model of the supply chain depicted in Figure 1 is not included in the system. *See App. Br. 4-5.*

The Examiner equates various entities in the flow chart of the supply chain in Figure 1 with the claimed model entities; for example, the Examiner equates the distributor in Figure 1 with the goal model entity. Answer 11-12. The Examiner further asserts that the goal hierarchy and the initiative hierarchy are shown in Figure 1 by the relationship between the entities; for example, the goal hierarchy includes all of the entities (*e.g.* supplier, assemblers) that supply a product to the distributor. *See Answer 12.* Finally, the Examiner asserts that the active document windows in Bhaskaran teaches the claimed graphical user interface because Bhaskaran discloses that access to various active documents in a business scenario can be given

or denied to the different role players (*i.e.* the entities in Figure 1) through the user interface based on sensitivity of information. Answer 12-13.

“The first issue we address with respect to obviousness is the scope and content of the prior art-specifically whether the prior art exhibited every step of the methods claimed in independent claims 1 and 31 of the ’099 patent.” *Miniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1324 (Fed. Cir. 2008).

We agree with the Appellants that Bhaskaran does not teach the claimed graphical user interface that permits a person to view model entities in a hierarchy of the hierarchies to which the model entities belong. First, we agree with the Appellants that Bhaskaran’s system does not include the depiction of the flow chart of the supply chain in Figure 1. App. Br. 5-6. Since the depiction of the flow chart of the supply chain in Figure 1 is not included in the system of Bhaskaran (FF 10), it cannot be viewed in the windows. We note that the Examiner admits that the flow chart of Figure 1 is not accessible to a processor. Answer 7 and FF 9.

Further, while Bhaskaran’s system does include an access control list as asserted by the Examiner (Answer 13-14), which includes the entities of the supply chain in Figure 1 (FF 6), Bhaskaran does not describe that the access control list permits viewing of the model entities in a hierarchy of the hierarchies to which the model entities belong. FF 11. *See* FF 6-8. For example, according to the Examiner’s rejection, the claimed initiative hierarchy includes final assemblers and sub-assemblers and that a goal hierarchy would include the distributor, final assemblers and sub-assemblers. Answer 8. The access control list of Figure 5 does not depict either of these hierarchies. Bhaskaran Fig. 5.

Finally, while a business scenario in Bhaskaran might include a description of the relationship between the entities in Fig. 1, Bhaskaran does not describe a business scenario or the associated active documents permitting viewing of the entities in a hierarchy of the hierarchies to which the model entities belong. FF 12.

We find that Bhaskaran does not teach the claimed graphical user interface that is structured to permit viewing of the model entities in a hierarchy of the hierarchies to which the model entities belong as asserted by the Examiner. We find that the Examiner failed to establish a prima facie showing of obviousness in rejecting claim 37. Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting claim 37 and claims 4-10, 38, and 40-43, dependent thereon, under 35 U.S.C. §103(a) as unpatentable over Bhaskaran and Official Notice I.

The rejection of claims 39 under §103(a) as being unpatentable over Bhaskaran, Official Notice I and Official Notice II.

This rejection is directed to a claim dependent on claim 37, whose rejection we have reversed above. For the same reasons, we will not sustain the rejection of claim 39 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious."). Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting claim 39 under 35 U.S.C. §103(a) over Bhaskaran, Official Notice I and Official Notice II.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), we enter a new ground of rejection. We reject claims 4-10 and 37-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 37 as representative, claim 37 recites a system that includes a representation of a model and a graphical user interface. We note that the Specification describes a representation of a model as tables in a relational database (Specification 29:13-14) and the graphical user interface in terms of software components such as menus (Specification 36:14-31). Giving claim 37 the broadest reasonable interpretation in light of the Specification, it would appear to encompass software per-se. Since a computer program per se³ is not patent-eligible subject matter, claim 37 is directed to subject matter that is non-statutory under §101.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 4-10 and 37-43 under 35 U.S.C. §103(a) as unpatentable over Bhaskaran.

We enter a new ground of rejection on claims 4-10 and 37-42 under 35 U.S.C. § 101.

³ See U.S. Patent & Trademark Office, Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, Aug. 2009, at 2, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf.

DECISION

The decision of the Examiner to reject claims 4-10 and 37-43 is reversed. We enter new grounds of rejection of claims 4-10 and 37-42 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50(b)

Appeal 2008-004673
Application 10/765,424

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